REMARKS/ARGUMENTS

Claims 1-4 and 7-9 are now pending in this application. Original claims 4 and 5 have been withdrawn due to the earlier Restriction Requirement.

Rejection Under 35 USC § 102(e)

The Examiner has rejected claims 1-4 and 7 under 35 USC § 102(e) as being anticipated by Katoh et al, U.S. Patent 6,630,472, alleging the present claims read on compounds of Table 1 in the patent, starting at columns 43-44.

Applicant has amended claims 1 and 2 and therefore the remaining claims dependent thereon, specifically to restrict the present compounds I claimed to bicyclic diamide compounds having a bis-difluoro group (i.e., group X is F_2).

The Katoh et al reference only discloses 6,6-bicyclic compounds having a dicarbonyl group off of the ring nitrogen atom (i.e. X is O).

Since the presently amended claimed compounds I do not contain X is O, there is no longer anticipation; and it is respectfully requested this rejection is no longer warranted and should be withdrawn.

Rejection Under 35 USC § 103(a)

The Examiner has rejected claims 1-4 and 7-9 under 35 USC § 103(a) for obviousness as being unpatentable over the Katoh et al reference. The reference teaches a generic group of diazabicyclo[3.3.1]nonnan-2-one derivatives which embraces applicants' claimed compounds (see columns 3-4, compounds of formula (I-a) and definitions for R^1, X and Y). The claims differ from the reference by reciting specific species and a more limited genus than the reference. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as taught for the genus as a whole. One of

ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. It has been held that a prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. *In re Susi*, 440 F.2d 442, 169 USPQ 423, 425 (CCPA 1971), followed by the Federal Circuit in *Merck & Co. v. Biocraft Laboratories*, 847 F.2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989).

The aforementioned amendment and remarks regarding the 35 USC §102(e) rejection, also apply with regard to this obviousness rejection.

The Katoh et al reference is limited to compounds where X is O and not X is F_2 as is now claimed herein. There are no examples or teaching in Katoh et al why one skilled in the art would make compounds where X is F_2.

It is respectfully requested that by the above amendment to the claims, this rejection has been obviated and should now be withdrawn.

In view of the above amendments and remarks, it is respectfully submitted this application is in condition for allowance and early and favorable action is respectfully requested.

Respectfully submitted,

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